

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims responsively to define the invention in clearer form and to distinguish patentably from the prior art.

Thus, applicant has amended claim 1 to avoid the Examiner's objections under 35 U.S.C. 112 by providing clarification with respect to the regulating valves of the flow regulating systems, as noted in the Office Action on page 2, paragraph 4.

Applicant has also amended claim 1 to respond to Item 1 of the Office Action on page 2.

Claim 9 has been cancelled and therefore the Examiner's objection noted in Item 2 of the Office Action on page 2, on the grounds of double patenting, has been overcome.

In considering the prior art, the Examiner is under the impression that the reference patent to Corradini (6,567,593) shows in Figure 14a and 14b, that the valves 30 to 34 are fixed bypass valves. This understanding of the reference patent to Corradini, however, is incorrect.

The definition of a fixed bypass valve may be obtained from the machine design handbook by DUDEL, 16th Edition 1987, pages V16 and V17. A copy of these two pages is being submitted for consideration by the Examiner. Should the Examiner require a translation of the pertinent subject matter, applicant will provide it.

Valves in the sense of applicant's invention, are fixed, non-varying passages in hydraulic paths. This is particularly shown in applicant's Figures 12 and 13.

The elements 30 to 34 shown in Figures 14a and 14b in the reference patent to Corradini, are not comparable with the fixed bypass valve in which the flow cross-section does not vary, as provided in applicant's arrangement.

It may be particularly seen in Figure 14b of the patent to Corradini, that the flow cross-section at reference numeral 104 on the valve 30 in front of the slider 31 is itself adjustable, depending on the flow velocity of the flow 104 and the spring characteristics of the spring 34.

As a result, the reference patent to Corradini does not disclose a fixed bypass valve as provided in applicant's invention.

The reference patent to Corradini, furthermore, also does not provide any indication or anticipation of arriving at applicant's invention.

Applicant has amended the base claim 1 to clearly define that the bypass valve has a non-varying flow cross-section.

Thus, the reference patent to Corradini discloses a hydraulic shock absorber with a progressive braking effect in which a hydraulic piston and cylinder are provided. The piston divides the cylinder into two chambers and in sliding by the piston, fluid flows from one chamber to the other. The flow is through ports and compression and extension valves that open and close progressively.

Unlike the reference patent to Corradini, applicant provides a flow regulating system having at least one shock-absorption component for a compression phase and for a decompression phase.

In applicant's invention, moreover, at least one valve assembly with electrically variable flow resistance is regulated by a regulating valve. At least one only fixed bypass valve with a non-varying constricted flow cross-section is hydraulically in parallel with the flow regulating system.

The flow regulating system for the compression phase, as well as for the decompression phase are in the form of the regulating valves with variable flow constriction.

The flow resistance is continuously variable in a step less manner for providing continuous damping between soft and hard

damping. The bypass valve prevents pressure pulses in damping fluid when the regulating valve transfer rapidly from open to closed positions corresponding to upward wheel shocks and sudden wheel accelerations.

As a result, in applicant's invention, sudden jolts are prevented when shifting between soft and hard damping for comfortable riding in a motor vehicle.

It is submitted that applicant's invention as detailed above, is not to be found in the reference patent to Corradini. Applicant provides for a new and marked improvement over the prior art. Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

The Examiner has applied the reference patents to Jensen, Miller, and Nezu for disclosing electrically variable valves in a shock absorber. However, applicant does not claim such means per se. Applicant claims such means only in combination with all of the other structure, elements and limitations as defined in the claims. Consequently, these references have no material bearing on applicant's invention, and they do not anticipate the novel features of applicant's arrangement.

The Examiner's attention is respectfully directed to the Court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the Court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention

correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

Furthermore, in the case of *ex parte* Chicago Rawhide Manufacturing Company (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of *The Standard Oil Company vs. American Cyanamid Company* (227 U.S.P.Q. 293), the Court decided that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive

systematic research or by extraordinary insight; it makes no difference which.

In combining references, as the Examiner suggests, applicant takes notes of the case *Uniroyal Inc. versus Rudkin-Wiley Corporation* (5 U.S.P.Q.2d 1434), in which it was ruled that when prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness of making the combination.

The preceding decision is reinforced by the case *In re Dow Chemical Company* (5 U.S.P.Q.2d 1529), in which the Court decided that most technological advance is the fruit of methodical persistent investigation, as is recognized in 35 U.S.C. §103. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

Furthermore, in the case of *United Merchants and Manufacturers Incorporated versus Ladd* (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device, and with advantage of hindsight, one might offhandedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the reference discloses or suggests the concept which is the crux of the invention.

In the case of *ex parte Fleischmann* (157 U.S.P.Q. 155), the Patent Office Board of Appeals ruled that while it might be possible to select features from secondary references and mechanically combine them with primary reference to arrive at

applicant's claim combination, there is no basis for making such combination disclosed or suggested in references; only applicant's specification suggests any reasons for combining references; under 35 U.S.C. 103, that does not constitute a bar.

Finally, in the case of Meng and Driessen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims, therefore, and in view of the preceding remarks, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

Should the Examiner require or consider it advisable that the specification and/or claims be further amended or corrected in formal respects to place the application in condition for final allowance, then it is respectfully requested that such amendments be carried out by Examiner's Amendment, through a phone call to applicant's representative, and the case passed to issue.

Respectfully submitted,

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